

REMARKS

The Office has required restriction among twenty-nine (29) allegedly patentably distinct inventions below:

In the following Groups I-V restriction among benzofurans which are substituted with a 2-(4-oxyphenyl) group and a 5-oxy- group is based on the 7-position substituent. Below they will be denoted as B.

I. Claim 6, drawn to B with hydrogen (i.e. unsubstituted at 7-), hydrocarbon or a halohydrocarbon moiety at 7 , classified in class 549, subclass 467.

II. Claim 6, drawn to B with a hydrocarbon group containing O or S singly bonded thereto at 7, classified in class 549, subclass 467.

III. Claim 6, drawn to B containing a group with a carbon double or triple bonded to a N, O or S atom at 7, classified in class 549, subclass 467.

IV. Claim 6, drawn to B containing amino, halogen, oxygen or nitro directly attached to 7, classified in class 549, subclass 467.

V. Claim 6, drawn to B containing a heteroaryl group directly attached at 7 as in o) and nnnnn), classified in class 548, subclass 143.

VI. Claim 6, drawn to benzofurans containing a 2-(4-oxyphenyl) group and a hydroxymethyl, carboxy or carboxylic acid ester group in the 5-position as in rrrr) thru tttt) , classified in class 549, subclass 467.

VII. Claim 6, drawn to benzofurans containing a 4-hydroxymethyl- or 4-carboxy- or 4-methoxycarbonylphenyl group in the 2-position as eeeee), ccccc) and ddddd) , classified in class 549, subclass 467.

VIII. Claim 6, drawn to benzofurans containing an acetyl group or its alcohol or oxime derivative in the 3-position as in nnnn), oooo) and pppp), classified in class 549, subclass 467.

IX. Claim S, drawn to biphenyl containing benzofurans as in iiiii) to IIII), classified in class 549, subclass 467.

X. Claim S, drawn to benzofurans substituted at 5- with halo, alkyl or haloalkyl as in mmm) to bbbb) classified in class 549, subclass 467.

XI. Claim 6, drawn to benzofuran boronic acid type compound jjj), classified Class 549, sub-class 213.

XII. Claim 6, drawn to benzaldehydes a), oo) and pp), classified in class 558, subclass 442.

XIII. Claim S, drawn to 1,4-dimethoxybenzenes tt), ss) and rr), classified in class 558, subclass 410.

- XIV. Claim 6, drawn to 1,2-di(substitutedphenyl)ethanones hhh), aaaa) and uu), classified in class 558, subclass 331.
- XV. Claim 8, drawn to 2-iodo-4-methoxy-S-nitrophenol cccc), classified in class 558, subclass 849.
- XVI. Claim 10 drawn to a method of treating prostatitis.
- XVII. Claim 11 drawn to a method of treating inflammatory bowel disease.
- XVIII. Claim 12 drawn to a method of treating cancer, etc.
- XIX. Claim 10 - a method of lowering cholesterol.
- XX. Claim 11- a method of cognition enhancement.
- XXI. Claim 12- a method of inhibiting free radicals.
- XXII. Claim 13 --a method of inhibiting vaginal atrophy.
- XXIII. Claim 14-a method of inhibiting vasomotor symptoms.
- XXIV. Claim 15- a method of inhibiting conception.
- XXV. Claims 16-18- a method for inhibiting arthritis, etc.
- XVI. Claim 19- a method of treating psoriasis.
- XXVII. Claim 20- a method of treating ischemia, etc.
- XXVIII. Claim 21-a method of treating endometriosis.
- XXIX. Claim 22- a pharmaceutical composition containing a compound of formula I. It is believed this is the subject of the last claim of applicants' US Patent 6,774,248.

In response to the requirement for restriction, Applicants hereby elect, with traverse, **Group XXVIII**, drawn to a method of inhibiting endometriosis, **claim 21**. In doing so, Applicants reserve the right to pursue the subject matter of the non-elected claims in one or more divisional or continuing application(s). Nevertheless, Applicants respectfully traverse the restriction requirement.

As will be appreciated, even if the Office considers the groups of claims to be patentably distinct, §803 of the M.P.E.P. mandates **two** criteria for a proper requirement for restriction: 1)the inventions must be independent or distinct; **and 2)there must be a serious burden on the examiner**. For purposes of initial restriction, a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search as defined in M.P.E.P. §808.02.

Applicants respectfully submit that there is no serious burden on the examiner particularly with regard to Groups I-IV, and VI-X all of which are classified in class 549 and subclass 467 and alternatively with respect to groups I-V, which are grouped in the Action itself. Since each of Groups I-IV, VI-X is in the same class and even the same subclass, these groups should be rejoined with each other since there is no serious burden on the examiner to search within the same class and subclass. The Action itself indicates similarity of treatment for groups I through V. Thus, Applicants do not see how there can be a serious burden on the examiner to search these groups together along with the elected method claim. Even if restriction is maintained between these groups and the method claims, Applicants respectfully request rejoinder of these groups on the record to aid in future prosecution.

Applicants note with appreciation the examiner's comments with regard to claim 22 and have canceled the claim without prejudice and without disclaimer of the subject matter therein.

Applicants respectfully request reconsideration of the requirement for restriction in light of the above comments. The non-elected claims have been indicated as withdrawn. In the event the restriction requirement is made final, Applicants hereby reserve their right to appeal and intend to cancel the non-elected claims without prejudice or disclaimer of the subject matter contained therein.

Although Applicants do not believe any fee is due, the Commissioner is hereby authorized to debit any fee due or credit any overpayment to deposit account 50-1275.

Early reconsideration and allowance of all pending claims is respectfully requested. The examiner is requested to contact the undersigned attorney if an interview, telephonic or personal, would facilitate allowance of the claims.

Respectfully submitted,

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